

REMARKS

Claims 1-44 are pending and rejected.

A. SPECIFICATION AMENDMENT

The section entitled Background of the Invention has been amended to update status information about applications incorporated by reference. No new matter has been added.

B. SECTION 101 REJECTION

Claims 1-33 and 40 are rejected under Section 101 as being directed to non-statutory subject matter because “there is no technology being used” in those claims. The Examiner cites a “technological arts” standard of a “two-prong test” allegedly established in In re Toma as the sole basis for rejecting Claims 1-33 and 40. [Office Action, pages 3-6].

There is no “technological arts” requirement for statutory subject matter. Ex parte Lundgren (BPAI 2005). Accordingly, we respectfully request that the Section 101 rejection of Claims 1-33 and 40 be withdrawn.

C. CLAIM OBJECTIONS

Claims 34, 38, and 41 are objected to as being of improper dependent form. As explained in our papers of September 20, 2001, and July 24, 2002, Claims 34, 38, and 41 are not and were not intended to be dependent claims—each is a proper independent claim. The proper fees have been provided for these independent claims. There is nothing we are aware of that prohibits a claim that refers to another claim from being considered an independent claim, particularly when, as explained in the above-noted papers, each claim objected-to may be infringed by something that does not infringe the claim to which it refers (the epitome of independence). We respectfully request the withdrawal of the Examiner’s objection to Claims 34, 38, and 41.

D. DOUBLE PATENTING REJECTION

All of pending Claims 1-44 stand “rejected under the judicially created doctrine of obviousness-type double patenting” as being unpatentable over specified claims of U.S. Patent No. 6,324,520.

We do not agree with this rejection. Claims 1-20 of U.S. Patent No. 6,324,520 include a feature generally directed to offering a substitute product if a selected first product is not available. None of the pending claims of this application (Claims 1-44) explicitly recites this feature, and the Examiner has not even attempted to explain why it would have been obvious to remove this feature

from the specified claims of U.S. Patent No. 6,324,520. None of Claims 21-48 of U.S. Patent No. 6,324,520 recites features of both receiving a selection of a product and offering an alternate product. The Examiner has not attempted to explain why it would have been obvious to modify any of the specified claims to provide for such features. Accordingly, the Examiner has failed to establish a prima facie case of obviousness-type double patenting.

E. SECTION 102(E) AND SECTION 103(A) REJECTIONS

1. Applicable Law

1.01. Prima facie burden

The examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a prima facie case of unpatentability. If examination at the initial stage does not produce a prima facie case of unpatentability, then without more the applicant is entitled to grant of the patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2D 1443, 1444 (Fed. Cir. 1992).

1.02. Claim interpretation must be consistent with the specification

During examination, claims are given their broadest reasonable interpretation that those skilled in the art would reach, consistent with the specification. *In re Hyatt*, 211 F.3d 1367, 1372, 54 U.S.P.Q.2D 1664, 1667 (Fed. Cir. 2000); *In re Cortright*, 165 F.3d 1353, 1359, 49 U.S.P.Q.2D 1464, 1468 (Fed. Cir. 1999). The “PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant’s specification.” *In re Morris*, 127 F.3d 1048, 1054-55, 44 U.S.P.Q.2D 1023, 1027 (Fed. Cir. 1997).

1.03. Substantial evidence required for all factual findings

The Board is not permitted to accept conclusory, unsupported findings made by the Primary Examiner that are not supported by substantial evidence made of record.

All findings of fact by the U.S. Patent and Trademark Office must be supported by substantial evidence within the record. *In re Gartside*, 203 F.3d 1305, 1315, 53 U.S.P.Q.2D 1769, 1775 (Fed. Cir. 2000).

The Supreme Court has described “substantial evidence” in the following manner:

substantial evidence is more than a mere scintilla. It means such relevant evidence as a reasonable mind might accept as adequate to

support a conclusion. . . . Mere uncorroborated hearsay or rumor does not constitute substantial evidence.

Consolidated Edison Co. v. NLRB, 305 U.S. 197, 229, 83 L. Ed. 126, 59 S. Ct. 206 (1938); see also, Dickinson v. Zurko, 527 U.S. 150, 162, 50 U.S.P.Q.2D 1930, 1935, 144 L. Ed. 2d 143, 119 S. Ct. 1816 (1999) (“Zurko III”).

“[R]eview under this standard involves an examination of the record as a whole, taking into consideration evidence that both justifies and detracts from the agency’s decision.” Universal Camera Corp. v. NLRB, 340 U.S. 474, 487-88, 95 L. Ed. 456, 71 S. Ct. 456 (1951); Zurko III, 527 U.S. at 162.

2. Independent Claims 1, 34, 36, 38, 40, 41, 43, and 44

All of the Section 102(e) and Section 103(a) rejections of the pending claims rely on alleged teachings of Walker et al. (U.S. Patent No. 6324520) (“Walker ‘520”). The Examiner has failed to establish any prima facie case of anticipation or obviousness of any pending claim.

The Examiner allegedly finds that Walker ‘520 discloses a method including all of the following steps:

- a. receiving a product selection from a customer (col 11, lines 24-25);
- b. determining if the product qualifies for an alternate product offer (col 11, lines 59-60);
- c. presenting an alternate product offer message to the customer (col 12, lines 22-23);
- d. determining if the customer has accepted the alternate product offer (col 12, lines 45-49); and
- e. dispensing the alternate product if the customer accepts the offer (col 12, lines 45-49 or the originally selected product if the customer does not accept the offer (col 13, lines 3-7).

[Office Action, page 9].

As explained in the instant application:

U.S. Application 09/164,670, filed October 1, 1998 [which issued as the cited Walker ‘520 reference], the disclosure of which is incorporated herein by reference, teaches a vending machine that offers products to undecided customers and suggests substitute products when the originally selected item is out of stock. The substitute product can be designated by the operator, based on historical likelihood of acceptance, or based on average selection time. This general approach works to offer a substitute product only when the requested product is unavailable.

[Specification, page 3, lines 15-21 (emphasis added)]. Thus, contrary to the Examiner's assertion, Walker '520 does not disclose performing a method that includes the following combination of steps:

- (1) receiving a product selection from a customer;
- (2) presenting an alternate product offer message to the customer; and
- (3) dispensing the originally selected product if the customer does not accept the offer. Walker '520 teaches that an alternate product offer message is presented only when an "originally selected product" is not available—there is no teaching of both presenting an alternate product offer message and dispensing the originally selected product.

As the Examiner has misinterpreted Walker '520 as teaching the specific combination of functions recited in independent Claims 1, 34, 36, 38, 40, 41, 43, and 44, the Examiner has failed to establish by substantial evidence that all of the claimed features of any pending claim were known or desirable. We respectfully request the withdrawal of the Section 102(e) and 103(a) rejections of Claims 1-44.

3. Dependent Claims

All of the dependent claims (Claims 2-33, 35, 37, 39, and 42) are allowable for at least the reasons stated above with respect to all of the independent claims.

3.01. Official Notice and Conclusory Assertions are not Substantial Evidence

The underlying factual determinations on which a conclusion of obviousness is allegedly based are reviewed to ascertain whether they are supported by substantial evidence. In re Kumar, 418 F.3d at 1365 (citing Gartside, 203 F.3d at 1316). Unsupported assessments of the prior art are unacceptable for purposes of review. "Rather, the Board must point to some concrete evidence in the record in support of these findings. To hold otherwise would render the process of appellate review for substantial evidence on the record a meaningless exercise." In re Zurko, 258 F.3d at 1385-86. "[D]eficiencies of the cited references cannot be remedied by the Board's general conclusions about what is 'basic knowledge' or 'common sense,'" nor may the Board simply reach conclusions based on its own understanding or experience. In re Zurko, 258 F.3d at 1385; Lee, 277 F.3d at 1344. "[T]he Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion." Lee, 277 F.3d at 1344.

3.02. Claims 20-22, 27, 28, 30, 31, and 33

We note that the Examiner rejects all of Claims 20-22, 27, 28, 30, 31, and 33 based on "Official Notice" and/or mere assertions "that it would be obvious" to provide for various recited features. [Office Action, pages 13-15]. The scope of asserted subject matter is limited to the extent it is supported by evidence of record. The Examiner does not indicate the locus of any evidence of record in support of the convenient assumptions about what would have been known and/or deemed desirable at the time of invention—"particular findings regarding the locus of the suggestion, teaching, or motivation to combine the prior art references" must be made. Dembiczak, 175 F.3d at 999-1000 ("Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight."). The Walker '520 reference does not appear to support the Examiner's alleged findings; the Examiner does not provide any other evidentiary basis for these assertions. Accordingly, the Examiner has failed to establish a prima facie case of obviousness of any of Claims 20-22, 27, 28, 30, 31, and 33. We request the withdrawal of all of the Section 103(a) rejections of Claims 20-22, 27, 28, 30, 31, and 33.

F. CONCLUSION


It is submitted that all of the claims are in condition for allowance. The Examiner's early re-examination and reconsideration are respectfully requested.

If the Examiner has any questions regarding this amendment or the present application, the Examiner is cordially requested to contact Michael Downs at telephone number (203) 461-7292 or via electronic mail at mtdowns@walkerdigital.com.

Respectfully submitted,

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